

Serial No. 10/614,708
September 15, 2005
Reply to the Office Action dated June 15, 2005
Page 10 of 13

REMARKS/ARGUMENTS

Claims 1 and 3-39 are pending in this application. By this Amendment, Applicant amends claim 1, cancels claim 2 and adds claims 21-39. Claims 6 and 11-20 have been withdrawn from further consideration as being directed to non-elected species. Applicant notes that claims 21-24 and 26-29 are directed to the elected species, and claims 25 and 30-39 are directed to non-elected species.

Applicant respectfully submits that claim 1 is generic. Since non-elected claims 6 and 11-20 depend upon generic claim 1, Applicant respectfully requests that the Examiner rejoin and allow claims 6 and 11-20 when generic claim 1 is allowed.

Similarly, Applicant respectfully submits that claim 21 is generic. Since claims 25 and 30-39 depend upon generic claim 21, Applicant respectfully requests that the Examiner allow claims 25 and 30-39 when generic claim 1 is allowed.

The drawings were objected because "figures 1-8 do not show cross-hatching of ceramic layers in each of the figures." Applicant respectfully disagrees.

The last paragraph of MPEP § 608.02 states that "the following symbols should be used to indicate various materials where the material is an important feature of the invention. The use of conventional features is very helpful in making prior art searches" (emphasis added). The third full paragraph on page 1 of the originally filed specification discloses that the use of ceramic layers 3 in a multilayer ceramic substrate is known. Thus, the ceramic layers 23 shown in Figs. 1-8 of the present application are clearly not important features of the invention. Therefore, Applicant respectfully submits that it is not necessary to cross-hatch the ceramic layers in the figures. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this objection.

Claims 1-4, 8 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's Admitted Prior Art Figure 8 (AAPA). Claims 5, 7 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Bird et al. (U.S. 5,831,810). Claim 2 has been canceled. Applicant respectfully traverses the rejections of claims 1, 3-5 and 7-10.

Serial No. 10/614,708
September 15, 2005
Reply to the Office Action dated June 15, 2005
Page 11 of 13

Claim 1 has been amended to recite:

“A multilayer ceramic substrate with a cavity comprising:
a multilayer composite member including a plurality of ceramic
layers disposed one on another;
a cavity formed in the multilayer composite member such that an
opening of the cavity is located in at least one principal surface of the
multilayer composite member;
a bottom-surface conductive film disposed on a bottom surface of
the cavity;
an electronic component disposed in the cavity; and
a capacitor conductive film disposed in the multilayer composite
member such that the capacitor conductive film faces the bottom-surface
conductive film via at least one ceramic layer; wherein
**the bottom surface conductive film is connected to a ground
potential; and**
**the bottom-surface conductive film and the capacitor
conducting film define a capacitor.”** (emphasis added)

Applicant's claim 21 recites features that are similar to the features recited in Applicant's claim 1, including the above-emphasized features.

With the unique combination and arrangement of features recited in Applicant's claims 1 and 21, including the features of “the bottom-surface conductive film is connected to a ground potential” and “the bottom-surface conductive film and the capacitor conductive film define a capacitor,” Applicant has been able to provide a multilayer ceramic substrate with a cavity constructed so as to have a very small total thickness (see, for example, the first full paragraph on page 4 of the originally filed specification).

The Examiner alleged that AAPA teaches all of the features recited in Applicant's claim 1.

Applicant's claim 1 has been amended to recite the features of “the bottom-surface conductive film is connected to a ground potential” and “the bottom-surface conductive film and the capacitor conductive film define a capacitor.” Applicant's claim 21 also recites these features.

In contrast to Applicant's claims 1 and 21, AAPA teaches a bottom-surface

Serial No. 10/614,708
September 15, 2005
Reply to the Office Action dated June 15, 2005
Page 12 of 13

conductive film 13 that is provided solely to apply a ground potential to the electronic component 8, and provides absolutely no capacitance (see, for example, the first full paragraph on page 3 of the originally filed specification). The only elements which provide a capacitance in the multilayer ceramic substrate of AAPA are metallic films 9 and 10, which together define a capacitor (see, for example, the second full paragraph on page 2 of the originally filed specification). However, neither of the metallic films 9 and 10 is disposed on the bottom surface of the cavity 8, or is connected to a ground potential.

Therefore, AAPA certainly fails to teach or suggest the features of "the bottom-surface conductive film is connected to a ground potential" and "the bottom-surface conductive film and the capacitor conductive film define a capacitor" as recited in Applicant's claims 1 and 21.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by AAPA.

The Examiner relied upon Bird et al. to allegedly cure various deficiencies of AAPA. However, Bird et al. fails to teach or suggest the features of "the bottom-surface conductive film is connected to a ground potential" and "the bottom-surface conductive film and the capacitor conductive film define a capacitor" as recited in Applicant's claims 1 and 21. Thus, Applicant respectfully submits that Bird et al. fails to cure the deficiencies of AAPA described above.

Accordingly, Applicant respectfully submits that AAPA and Bird et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant's claims 1 and 21.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1 and 21 are allowable. Claims 3, 4 and 6-10 and 22-39 depend upon claims 1 and 21, and are therefore allowable for at least the reasons that claims 1 and 21 are allowable. In addition, Applicant respectfully requests that the Examiner rejoin and allow non-elected claims 6 and 11-20 along with allowable generic claim 1.

In view of the foregoing amendments and remarks, Applicant respectfully submits

Serial No. 10/614,708
September 15, 2005
Reply to the Office Action dated June 15, 2005
Page 13 of 13

that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: September 15, 2005


Attnorneys for Applicant

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
8180 Greensboro Drive, Suite 850
Tyson's Corner, VA 22102
Telephone: (703) 637-1480
Facsimile: (703) 637-1499